



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Fan JIAO

Serial No.: 09/435,015

Filed: November 5, 1999

For: DIRECTORY-ENABLED NETWORK  
ELEMENTS

Confirmation No.: 4659

Group Art Unit No.: 2131

Examiner: Syed ZIA

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**

AUG 10 2004

Technology Center 2100

**REPLY TO FINAL OFFICE ACTION**

Sir:

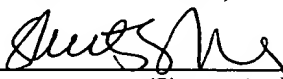
In reply to the Office Action mailed June 9, 2004, for which the shortened statutory time for reply extends to September 9, 2004, Applicant respectfully requests reconsideration of the application in light of the remarks herein.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on August 6, 2004  
(Date)

by

  
(Signature)

## I. SUMMARY OF NEW GROUNDS OF REJECTIONS

Claims 1-5, 7-10, 15-17, and 20-24 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Harrison et al. Claim 6 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Harrison et al. in view of Day II et al. Claims 11-14 and 25-26 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Harrison et al. in view of Baum et al. Claims 18 and 19 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Harrison et al. in view of Nessett et al.

## II. DECLARATION OVERCOMING REJECTIONS UNDER 35 U.S.C. §§102-103

The Office Action stated,

The evidence submitted is insufficient to establish a *conception of the invention*...(emphasis added).

However, the Applicant has never attempted to establish a date of conception of the invention and is not required to do so. Specifically, MPEP 715.07, p. 700-250, states

As discussed above, 37 CFR 1.131(b) provides *three ways* in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; *or*

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; *or*

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice)...(emphasis added).

Reduction to practice and conception of invention are alternative ways of showing prior invention. The response filed March 22, 2004 expressly stated, that the Applicant elects to establish actual *reduction to practice* prior to September 10, 1999, which is the effective date as a reference of Harrison et al. Additionally, the Declaration states

2. I am aware that the purpose of this Declaration is to establish sufficient facts from which one can conclude that an embodiment of the invention was ***reduced to practice*** prior to September 10, 1999....

6. Cisco Systems, Inc. commercially released an embodiment of the invention before September 10, 1999, but not more than a year before the filing date of the present patent application, as part of the following Cisco software products: CNS for Client for IOS in IOS Release 12.0.4; and CNS for IOS II for IOS Release 12.0.5. Both the products CNS for Client for IOS in IOS 12.0.4 and CNS for IOS II for IOS 12.0.5 are referenced in Patent Idea Details for Idea #41685.

7. An embodiment of the invention was included in the products associated with CNS for Client for IOS in IOS 12.0.4 and CNS for IOS II for IOS 12.0.5. The products associated with CNS for Client for IOS in IOS 12.0.4 and CNS for IOS II for IOS 12.0.5 were released for sale before September 10, 1999 ... (emphasis added).

The Applicant has established that the invention was reduced to practice prior to the filing date of the reference. The Applicant is not attempting to prove conception of invention. Although the Declaration avers that Exhibit I includes documents describing at least one embodiment of the invention, this is only for the purpose of establishing that the redacted dates of release in the documents of Exhibit I are dates of release for at least an embodiment of the invention, which is evidence of reduction to practice. Reconsideration is respectfully requested.

The Office Action further argued,

Applicant clearly has failed to demonstrate the date(s) of conception life cycle by leaving the date column blank from the version control history of different phases of evolving invention document.

The Applicant requests a citation of any statute, rule, case law, or MPEP section to support this position, because the premise of this statement is incorrect. An Applicant is not required to provide specific dates to establish reduction to practice. MPEP 715.07, p. 700-233, expressly states,

#### **ESTABLISHMENT OF DATES**

***If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.***

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, *he or she may merely allege that the acts referred to occurred prior to a specified date...*(emphasis added).

MPEP 715.07 expressly permits the exhibits to have the dates “removed or blocked off”, and allows the dates to be taken care of by the Applicant merely alleging in the Declaration “that the acts referred to occurred prior to a specified date”, which is the filing date of the reference being over come. When establishing reduction to practice the omission or redaction of dates is a long established practice that has developed to enable applicants to provide antedating affidavits or declarations without revealing information that could be prejudicial in future interference proceedings or in future litigation in which date of invention could be an issue. Reconsideration is respectfully requested.

The Office Action also stated,

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another.

The Applicant disagrees. This statement references principles related to proving conception of invention, and mistakenly applies those principles to a Declaration establishing reduction to practice. This statement also incorrectly implies that the subject matter of the claims is not disclosed in the documents of Exhibit I. As some representative examples, claim 1 recites “A directory-enabled network device.” Similarly, claim 13 recites “A directory enabled network switch for a packet switched network.” Claims 11, 21, 25, and 26 recite similar subject matter as that of claims 1 and 13. The Summary of the disclosure document, entitled “Idea Details (#141685)”, refers a “Directory Enabled Network Element” (which in-and-of-itself is a description of an embodiment of claim 1) and the disclosure document states,

A set of core Directory Service agents are built into router software (IOS) such that a router is authenticated to Directory automatically when it is powered up....

Thus, the subject matter of claims 1, 11, 13, 25, and 26 is disclosed in the disclosure document. However, the relevance of the disclosure document (and the other documents of Exhibit 1) encompassing at least one claimed embodiment is not in establishing conception, but that the device that was *released for sale* (and therefore that the device that was reduced to practice) was an embodiment of the invention.

Additionally, reduction to practice does not require that the Applicant demonstrate that the device was described, but instead requires that the Applicant provide evidence that the device existed and was adequately operational. Regarding requirements for providing actual reduction to practice in interference practice (which are more stringent than the requirements under 37 CFR §1.131), MPEP 2138.05 states

#### **REQUIREMENTS TO ESTABLISH ACTUAL REDUCTION TO PRACTICE**

"In an interference proceeding, a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000).

Providing evidence that a product was released for sale prior to a particular date meets both of these requirements for establishing evidence for reduction to practice. Cisco Systems, Inc. would not sell the product if it was not believed to function adequately for its intended purpose since that would seriously undermine its reputation and eventually seriously hurt Cisco Systems, Inc.'s sales revenues. For example, MPEP 2138.05 also states,

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, ***but it need not be in a commercially satisfactory stage of development***. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985) ...(emphasis added).

Thus, a commercially satisfactory stage of development is a further stage of development beyond mere reduction to practice. Consequently, a release for sale shows that a device is at a further stage of development than reduction to practice, and therefore the evidence that an embodiment of the invention was released for sale is certainly evidence of reduction to practice.

The Office Action further alleges that the Applicant has not pointed out the differences between the prior art and the claims. However, this is not necessary in view of the declaration filed by the Applicant under 37 CFR §1.131 and the supporting documents. As stated in the prior response, since the effective date of Harrison et al. as a reference is September 10, 1999, the Declaration is sufficient to require the Office to remove Harrison et al. as a reference in a rejection over art and to overcome a rejection under 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a). Since all of the rejections of the Office Action rely on Harrison et al. alone or in combination with another reference, all the rejections over art should be removed.

### III. CONCLUSIONS

For the reasons set forth above, all pending claims are patentable over the art of record. Accordingly, allowance of all claims is hereby respectfully solicited.

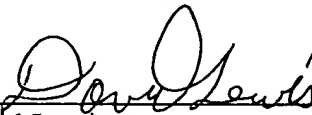
The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

No extension fee is believed to be due. However, to the extent necessary, Applicants petition for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in relation to this application to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: August 6, 2004

  
\_\_\_\_\_  
David Lewis  
Patent Agent, Reg. No. 33,101

1600 Willow Street  
San Jose, California 95125-5106  
Telephone No.: (408) 414-1213  
Facsimile No.: (408) 414-1076